

REMARKS

This application has been amended in a manner that is believed to place it in condition for allowance at the time of the next Official Action.

Claims 39, 42-46, and 52-56 are pending in the present application. Claims 39, 43, 45, and 46 have been amended. Claims 39 and 46 have been amended to delete the term "isolated". As the polypeptide of claims 39 and 46 is a molecule that is not believed to exist in nature, applicants respectfully submit that the term "isolated" is not necessary to distinguish the claims from nature. Claims 43 and 45 have been amended to delete the term "pharmaceutically acceptable". Claim 48 has been canceled. Claims 53 and 54 have been indicated as allowable.

In the outstanding Official Action, claims 43, 45, and 48 were rejected under 35 USC §112, first paragraph, as allegedly not satisfying the enablement requirement. Applicants believe the present amendment obviates this rejection.

As noted above, claims 43 and 45 have been amended to delete the references to a "pharmaceutical". Claim 48 has been canceled.

When a compound or composition claim is not limited by recited use, any enabled use that would reasonably correlate with the entire scope of that claim is sufficient to preclude a rejection for non-enablement based on how to use (MPEP

§2164.01(c)). While applicants do not disclaim any potential applications or utilities for the claimed polypeptide, applicants believe that the present amendment obviates the enablement rejection in that the recitations directed to a "pharmaceutical" have been removed from the claims.

Thus, in view of the above, applicants respectfully request that the rejection be withdrawn.

Claims 39, 42-46, 48, 52, 55 and 56 were rejected under 35 USC §102(b) as allegedly being anticipated by HELMBY et al. Applicants believe that HELMBY et al. fail to anticipate the claimed invention.

In imposing the rejection, the Office Action alleges that the characteristics such as the amino terminal part, the number of amino acids as well as the binding capabilities would be inherent in the protein of the prior art. The Office Action also concluded that the specifically claimed portion of SEQ ID NO: 1 would appear to have a similar molecular weight (see Office Action on page 10). However, this is not the standard for determining whether the publication inherently discloses a recitation.

Indeed, in order for a publication to anticipate a claim on the grounds that it is inherently set forth in the publication, the inherency must be certain. Indeed, the fact that a publication may inherently have the characteristics of the

claimed product, is insufficient. The inherency must be a necessary result and not merely a possible result. *In re Oelrich*, 666 F.2d 578, 212 USPQ 323 (CCPA 1981). As acknowledged by the Office Action, HELMBY et al. fail to teach the amino terminal part, the number of amino acids as well as the binding capability. However, applicants respectfully submit that the Office Action does not provide any evidence to support this position. Rather, the rejection is based on the assumption that the claimed polypeptides appear to or might be anticipated by HELMBY et al. Thus, there is no indication in the HELMBY et al. reference that it is certain that the disclosed polypeptides have the same characteristics. In view of the above, applicants believe that HELMBY et al. fails to anticipate the claimed invention.

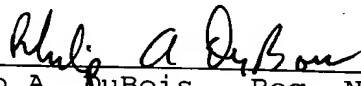
In view of the present amendment and the foregoing remarks, therefore, applicants believe that the present application is in condition for allowance at the time of the next Official Action. Allowance and passage to issue on that basis are respectfully requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any

overpayment to Deposit Account No. 25-0120 for any additional  
fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17

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PD/mjr

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